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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,728	11/20/2003	David A. Fishman	Fishman 13-4-2	8698
23307 7590 09/13/2007 SYNNESTVEDT & LECHNER, LLP 1101 MARKET STREET 26TH FLOOR PHILADELPHIA, PA 19107-2950			EXAMINER GESESSE, TILAHUN	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/717,728

### Applicant(s)

FISHMAN ET AL.

### Examiner

Tilahun B. Gesesse

### Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-21 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 9-13, 22-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 6/212/07 have been fully considered but they are not persuasive for the following reasons.

On page 5, second paragraph of applicant response , applicant argued that Ito does not teach multi-tiered service as claimed.

The examiner disagrees. Ito teaches broadcast program and advertisement program (see abstract of Ito) then, Ito teaches tier (grouped ) broadcast service , the conventional broadcast program and advertisement program services.

The recitation that "multi-tiered" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8,14-21,27-33are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US 7,120,921).

Claim 1,Ito teaches a method for providing multi broadcast services to subscribers (see column 7, line 56-column 8, line 58 and figure 1) .

Ito teaches broadcasting primary content over one or more channels ( column 7, lines 56-65) in which the receiving processor receives multi-channel digital satellite broadcast such as a program broadcasting content based on identifying an ID belonging the program broadcast .

Ito teaches broadcasting secondary content over one or more secondary channels (see column 7, lines 58-65 in which receiver 101 receives multi channel digital satellite broadcast such as advertisement information from the broadcast by identifying ID belonging to the advertisement broadcast.

Ito teaches enabling reception of a second broadcast service whereby subscribers subscribing to the second broadcast receive both the primary and the secondary content (see column 9, lines 29-39).

Ito differs in teaching enabling reception of a first broadcast service whereby

subscribing to the first broadcast service receive only the primary content.

However, Ito teaches a subscriber receives a program information through digital satellite broadcast replay the program content only while the advertisement being stored in the memory (see column 9, lines 29-39). Then, it would have been obvious to an ordinary skill in the art at the time of the invention was to receive a program content only in order to avoid advertisement while listening music.

Claims 2-3, Ito inherently teaches primary content comprises substantives programming content and the secondary content comprises promotional content (commercial advertising) (program information and advertisement information broadcast usually contains promotional or commercial advertisement content).

Claims 4-6, Ito teaches the primary content channels is associated with at least one secondary content channel and associate with different secondary content channel (see figure 1 in which programs and advertisement frames transmit or broadcast from satellite that contains promotion or commercial advertisements).

Claim 8, Ito teaches requiring the second broadcast subscribers play at least a portion of the secondary content before being able to play the primary content (upon control panel 103 reproduced play before main program see column 9, lines 40-56).

Claim 14, Ito teaches a system for providing multi broadcast services to subscribers (see column 7, line 56-column 8, line 58 and figure 1) comprising:

Ito teaches means for broadcasting primary content over one or more channels (column 7, lines 56-65) in which the receiving processor receives multi-channel digital

satellite broadcast such as a program broadcasting content based on identifying an ID belonging the program broadcast .

Ito teaches means for broadcasting secondary content over one or more secondary channels (see column 7, lines 58-65 in which receiver 101 receives multi channel digital satellite broadcast such as advertisement information from the broadcast by identifying ID belonging to the advertisement broadcast.

Ito teaches means for enabling reception of a second broadcast service whereby subscribers subscribing to the second broadcast receive both the primary and the secondary content (see column 9, lines 29-39).

Ito differs in teaching means for enabling reception of a first broadcast service whereby subscribing to the first broadcast service receive only the primary content.

However, Ito teaches a subscriber receives a program information through digital satellite broadcast replay the program content only while the advertisement being stored in the memory (see column 9, lines 29-39). Then, it would have been obvious to an ordinary skill in the art at the time of the invention was to receive a program content only in order to avoid advertisement while listening music.

Claims 15-16,29 Ito inherently teaches primary content comprises substantives programming content and the secondary content comprises promotional content (commercial advertising) (program information and advertisement information broadcast usually contains promotional or commercial advertisement content).

Claims 17-20,31-33 Ito teaches the primary content channels is associated with at least one secondary content channel and associate with different secondary content channel (see figure 1 in which programs and advertisement frames transmit or broadcast from satellite that contains promotion or commercial advertisements).

Claims 21,33, Ito teaches requiring the second broadcast subscribers play at least a portion of the secondary content before being able to play the primary content (upon control panel 103 reproduced play before main program see column 9, lines 40-56).

Claims 27-28, Ito teaches a computer product for providing multi broadcast services to subscribers , a computer readable storage medium having computer readable program code embodied in the media (see column 7, line 56-column 8, line 58 and figure 1) comprising:

Ito teaches a computer readable program code that controls the broadcasting primary content over one or more channels( column 7, lines 56-65) in which the receiving processor receives multi-channel digital satellite broadcast such as a program broadcasting content based on identifying an ID belonging the program broadcast .

Ito teaches a computer readable program that controls the broadcasting secondary content over one or more secondary channels (see column 7, lines 58-65 in which receiver 101 receives multi channel digital satellite broadcast such as advertisement information from the broadcast by identifying ID belonging to the advertisement broadcast.

Ito teaches computer readable program code that enabling reception of a second broadcast service whereby subscribers subscribing to the second broadcast receive both the primary and the secondary content (see column 9, lines 29-39).

Ito differs in teaching enabling reception of a first broadcast service whereby subscribing to the first broadcast service receive only the primary content.

However, Ito teaches a subscriber receives a program information through digital satellite broadcast replay the program content only while the advertisement being stored in the memory (see column 9, lines 29-39). Then, it would have been obvious to an ordinary skill in the art at the time of the invention was to receive a program content only in order to avoid advertisement while listening music.

#### ***Allowable Subject Matter***

4. Claims 9-13,22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach tracking how much of the secondary content has been played by the secondary subscriber and discontinuing the requirement that the second subscriber play back the secondary content upon the occurrence of a first predetermined triggering event.



***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 571-272-7879. The examiner can normally be reached on flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 571-272-7899.

The Central FAX Number is 571-273-8300. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number .

Information regarding the status of an application may be obtained from

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the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TG

August 27, 2007



TILAHUN GESESSE  
PRIMARY EXAMINER